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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/526,673      | 03/04/2005  | Hirokazu Tohya       | 8029-1072           | 7444             |

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| EXAMINER |
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GLENN, KIMBERLY E

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| ART UNIT | PAPER NUMBER |
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2817

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 01/22/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/526,673

Applicant(s)

TOHYA ET AL.

Examiner

Kimberly E. Glenn

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-52 and 62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-35 37-42, 46-52 62 is/are rejected.
- 7) ☐ Claim(s) 36 and 43-45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/4/05</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 42, 44 and 45 are objected to because of the following informalities:  
Applicant recites "the second electrode leading terminal" in above disclose claims. The second electrode leading terminal should be changed to - - the second electrode leading terminals. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-40, 42, 46-52 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

#### **Claim 33**

Claim 33 recites the limitation "the metal member" in line 11. There is insufficient antecedent basis for this limitation in the claim.

In line 12, applicant recites "through holes", are these through holes the same through holes recited in line 9?

#### **Claim 40**

In lines 2 and 4, applicant recites the electrode leading terminal which terminal (i.e. first electrode terminals or the second electrode terminals) is applicant referring?

#### **Claim 42**

In line 16, applicant recites "a wire", is this wire the same wire recited in line 6?

Claim 46

Claim 46 recites the limitation "the first leg member, the second leg member, the first body member and the second body member " in lines 2 and 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 62

Claim 62 recites the limitation "the strip line " in 8. There is insufficient antecedent basis for this limitation in the claim.

***Election/Restrictions***

With regards to applicant remarks concerning the election/restriction requirements the election restriction has been withdrawn. An office action based on claims 33-52 and 62 follows.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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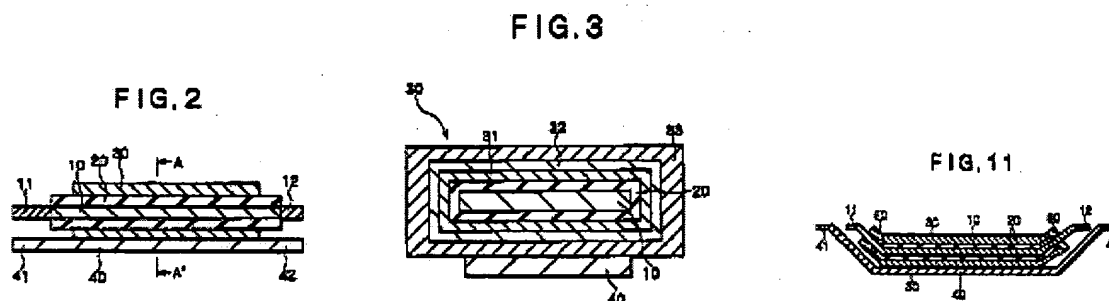
consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 33-35, 37-39, 41, 47-52 are rejected under 35 U.S.C. 103(a) as being obvious over Masuda et al US Patent 6,721,171 in view of Arai et al UK Patent GB 2 393 334 A.

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Masuda et al discloses a shield stripline devices comprising a metal (10) having a valve action; a dielectric oxide film (20) formed on a surface of the metal having the valve action; and a conductive polymer layer (20) formed around the metal having the

valve action via the dielectric oxide film; wherein a pair of first electrode leading terminals (11 and 12) is provided on both ends in a longitudinal direction of the metal having the valve action, and a pair of second electrode leading terminals (41 and 42) is provided. the metal (10) having the valve action is rectangular ( or circular , oval plate, foil) in cross section. The ends of the stripline device are bent or curved. (Figure 11). The metal having the valve action has a longitudinal width larger than a cross sectional width. The conducting polymer is one or more compounds selected from the group consisting of polypyrrole, polythiophene, and polyaniline, or a derivative of the compounds. A conductive carbon paste (32) and a silver paste (33) formed on the conducting polymer layer (31 Figure 3). The metal member is fixed on the conductive paste layer. The metal having the valve action is a metal selected from the group consisting of aluminum, tantalum, and niobium. The metal having the valve action, the dielectric coating, and the conductive material layer are molded with resin. The shielded strip line device to be mounted on a circuit board or an electronic substrate. The anode lead terminals 11 and 12 are bent and the cathode lead terminals 41 and 42 at the respective ends of metal plate 40 and the tips of anode lead terminals 11 and 12 are arranged to lie in the same plane to facilitate surface mounting onto a circuit board. (Column 4;line 43 through column 7; line 2)



Thus, Masuda et al is shown to teach all limitation of the claim with the exception of the second electrodes provided at a different position than the first electrodes, the terminals connected to the printed wiring board through vias and the metal having a ring shaped cross section.

Aria et al disclose in figure 6B, a transmission line device comprising a tantalum fine wire 1, a conductor layer 2, a first anode terminal 3a, a second anode terminal 3b, a cathode terminal 5, and a capacitance forming portion 6.

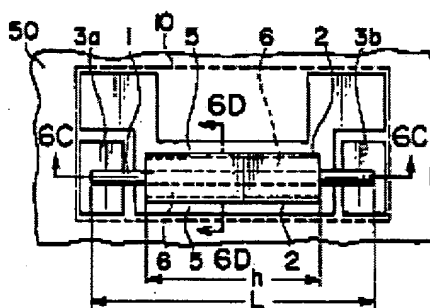


FIG. 6B

Thus, one of ordinary skill in the art would have found it obvious to replace the straight metal plate of with the U shaped electrode as taught by Aria et al. The motivation for this modification would have been to provide an art recognized electrode having offset ends, which would facilitate alternative connection position.

One of ordinary skill in the art would have found to obvious to use vias as means of connection the terminals to the printed wiring board since vias are well known connection means.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 41 is rejected under 35 U.S.C. 102(e) as being anticipated by Masuda et al US Patent 6,721,171.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Masuda et al disclose stripline device, comprising a metal having (10) a valve action, a dielectric oxide film (20) formed on a surface of the metal, a conductive polymer layer (30) formed around the metal via the dielectric coating, and a metal plate (40) which is disposed in contact with the conductive polymer layer and transmits direct-current power, wherein: the stripline device includes a first electrode leading terminals (11 12) for connecting an end of the metal having the valve action; second electrode leading terminals(41 and 42) connected to the printed wiring board are integrally



formed on the metal member; and the second electrode leading terminals and the first electrode leading terminals connected to both ends of the metal having the valve action form four terminals. The shielded strip line device to be mounted on a circuit board or an electronic substrate. The anode lead terminals 11 and 12 are bent and the cathode lead terminals 41 and 42 at the respective ends of metal plate 40 and the tips of anode lead terminals 11 and 12 are arranged to lie in the same plane to facilitate surface mounting onto a circuit board.

#### ***Allowable Subject Matter***

Claims 36 and 43-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Meyer US Patent 5,500,629, Arai et al US Patent 6,646,523, Arai et al US Patent 6,836,195, Masuda et al US Patent 6,873,518, Arai et al US Patent 6,911,880. And Aria et al US Patent 7,005,944.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly E. Glenn whose telephone number is (571)-272-1761. The examiner can normally be reached on Monday-Friday 7:30 to 4:00.

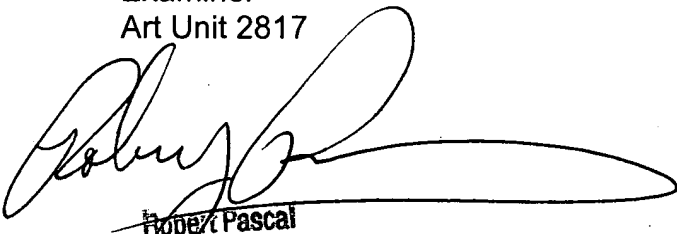
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pascal can be reached on (571)-272-1769. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

20061221 keg

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